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PATENT APPLICATION

**RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 2837**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Hideki HISADA et al.

Application No.: 10/069,395

Filed: April 3, 2002

For: DRIVE APPARATUS

Group Art Unit: 2837

Examiner: T. Smith

Docket No.: 112061

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the August 11, 2004 Office Action, reconsideration of the above-identified application is respectfully requested. Claims 1 and 3-29 are pending.

Applicants filed an Information Disclosure Statement on May 20, 2002. In the Request for Reconsideration filed May 19, 2004, Applicants requested consideration of the references cited in that Information Disclosure Statement. However, an initialed Form PTO-1449 was not returned. In paragraph one of the Office Action mailed February 23, 2004, the Examiner asserts that the Information Disclosure Statement filed on May 20, 2002 fails to comply with 37 C.F.R. 1.97(d) because it lacks a statement as specified in 37 C.F.R. 1.97(e). This statement is not correct.

Applicants filed an Information Disclosure Statement on May 20, 2002. This date is within three months of the date of entry of the National Stage (i.e., February 26, 2002) and

before the mailing of the first Office Action on the merits (i.e., August 11, 2003).

Accordingly, Applicants assert that they have satisfied both 37 C.F.R. 1.97(b)(2) and 37 C.F.R. 1.97(b)(3). Applicants do not have to satisfy 37 C.F.R. 1.97(d). In fact, an event triggering 37 C.F.R. 1.97(d) has not occurred. In other words, Applicants have yet to receive a Final Rejection, a Notice of Allowance or any action that otherwise closes prosecution in the application. Applicants do not have to provide a statement as specified in 37 C.F.R. §1.97(e). Accordingly, it is respectfully requested that the Examiner consider the eight references submitted with the May 20, 2002 Information Disclosure Statement, the concise explanation of relevance being provided for reference one in the present specification and the concise explanation of relevance being provided for references 2-8 in the International Search Report.

Claims 1, 3, 4 and 11-29 were rejected under 35 U.S.C. §103(a) over Koide et al. (Koide), U. S. Patent No. 5,934,395 in view of the Tsuzuki et al. (Tsuzuki), U. S. Patent No. 6,018,198 and Yamaguchi et al. (Yamaguchi), U. S. Patent No. 6,546,319. The rejection is respectfully traversed.

As admitted in the Office Action, neither Koide nor Tsuzuki disclose causing an first electric motor to output a torque short of a torque necessary for running the engine continuously as recited in claim 1 and as similarly recited in claim 29.

Yamaguchi is disqualified as prior art under 35 U.S.C. §103(c). In particular, Yamaguchi can only qualify as prior art under 35 U.S.C. §102(e) because Yamaguchi has a filing date of May 23, 2001 and this application has an international filing date of July 11, 2001. (Applicants note that the priority document, Japanese Patent Application No. 2000-209587 was filed on July 11, 2000 which is prior to May 23, 2001.) Furthermore, both this application and Yamaguchi are both commonly assigned to Aisin AW Co., Ltd. According to 35 U.S.C. §103(c), the subject matter developed by Yamaguchi, which qualifies

as prior art only under 35 U.S.C. §102(e) shall not preclude patentability under 35 U.S.C. §103 where the subject matter and the claimed invention were, at the time the invention was made, subject to an obligation of assignment to Aisin AW Co., Ltd.

Paragraph four of the Office Action agrees that Yamaguchi is disqualified as prior art through 35 U.S.C. §102(e) in any rejection under 35 U.S.C. §103(a). However, the Office Action again asserts a rejection under 35 U.S.C. §103(a) over Yamaguchi. A rejection under 35 U.S.C. §103(a) cannot be maintained when the Office Action agrees that Yamaguchi is disqualified as prior art and admits that Koide and Tsuzuki fail to disclose or suggest all of the features recited in claims 1 and 29.

Paragraph four of the Office Action then continues by stating that the foreign priority document is not perfected because an English language translation has not been provided. It also appears that the Office Action justifies the assertion of Yamaguchi by stating that the English language translation has not been provided. This statement represent a misunderstanding of 35 U.S.C. §103(c), 35 U.S.C. §119 and 37 C.F.R. §1.55.

An English language translation of the priority document, Japanese Patent Application No. 2000-209587, is not necessary in order to disqualify Yamaguchi under 35 U.S.C. §103(a). Applicants only have to establish that Yamaguchi only qualifies as prior art under 35 U.S.C. §102(e) and that both this application and Yamaguchi are both commonly assigned. In order to qualify as prior art only under 35 U.S.C. §102(e), only the international filing date of July 11, 2001 has to be asserted. The filing date of July 11, 2000 for the priority document does not have to be asserted. No where is it disclosed in 35 U.S.C. §103(c), 35 U.S.C. §119 and 37 C.F.R. §1.55 that Applicants must establish the earliest filing date. An English language translation is not necessary in order to disqualify Yamaguchi under 35 U.S.C. §103(c).

Requiring an English language translation is also contrary to Patent Office policy. According to M.P.E.P. § 201.15, the only time during *ex parte* prosecution that the Examiner considers the merits of Applicants' claim of priority is when a reference is found with an effective date between the date of the foreign filing and the date of filing in the United States. Applicants may argue the rejection if it is of such a nature that it can be argued. In this Application, Applicants argued that Yamaguchi is disqualified as prior art under 35 U.S.C. § 103(c). If the Applicants argue the reference, the Examiner may specifically require the foreign papers to be filed in addition to repeating the rejection if it is still considered applicable. In this Application, the Office Action agrees that Yamaguchi is disqualified as prior art under 35 U.S.C. §103(c). As such, the rejection can not be considered applicable when Yamaguchi is admittedly disqualified and the Office Action admits that Koide and Tsuzuki fail to disclose or suggest all of the features recited in claims 1 and 29.


Accordingly, because Koide and Tsuzuki fail to disclose all of the features recited in claims 1 and 29 as admitted in the Office Action and Yamaguchi is disqualified as prior art. It is respectfully requested that the rejection be withdrawn.

Applicants appreciate the indication of allowability for claims 5-10. However, for the reasons discussed above, Applicants assert that all of claims 1 and 3-29 are allowable.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1 and 3-29 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:SMS/sxb

Date: November 12, 2004

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